

Application No.: 09/809,638

Docket No.: 511582003500

REMARKS

Claims 1, 14, and 23 are pending and stand rejected. The following remarks and supplemental information are offered in response. Reconsideration is respectfully requested.

Sufficiency of the Rule 131 Declaration

Claims 1, 14, and 23 were rejected as allegedly being anticipated by WO 2002/70539 A2. Applicants submitted a declaration under 37 C.F.R. § 1.131, and later a reproduction of the laboratory notebook of Steven C. Mitchell, noting the sequencing of the claimed cloned. The Office indicated in the Advisory Action mailed August 17, 2005, that it did not consider this information to put the claims in condition for allowance.

When a claim of an application is rejected, the applicant may submit an oath or declaration under Rule 1.131 to establish invention of the subject matter of the rejected claim prior to the effective date of the reference. 37 C.F.R. § 1.131. The 37 C.F.R. § 1.131 oath or declaration is required to show no more than the reference shows. *In re Stryker*, 435 F.2d 1340, 168 USPQ 372 (CCPA 1971). “[O]nce an inventor has completely reduced his invention to practice, he is not required . . . to show subsequent diligence in applying to the Patent Office for patent protection.” *Conner v. Joris*, 241 F.2d 944, 951 (CCPA 1957). Only where conception occurs prior to the date of the reference, but reduction to practice is afterward, does the applicant need to show evidence of diligence. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm’r Pat. 1889); M.P.E.P. § 715.07(a).

Here, the Office cited WO 2002/70539 against the pending claims as an allegedly anticipatory reference. The cited reference was filed on March 5, 2002, which is after the filing date of the present application. The cited reference claims priority to U.S. Patent Application No. 09/799,451, which was filed on March 5, 2001, which predates the present application’s filing date of March 14, 2001 by 9 days.

Applicants submitted a declaration under Rule 1.131 to antedate the cited reference. Data, in the form of a reproduced page from the notebook Dr. Steven C. Mitchell, was provided to the Office to support the declaration. The Office alleged that the page was not legible and that it was not clear

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to the Office how this data provided the requisite proof of prior invention. Applicants respectfully submit the present response, additional proof of prior invention, and the following remarks to address the issues raised in the Advisory Action.

Applicants submit herewith a reproduction of an electronic mail message from Dr. Mitchell to his colleagues regarding the nucleotide sequence and amino acid sequence of the present invention. The date of the message is January 3, 2001. As such, this document clearly supports the statements made in the previously submitted Rule 1.131 declaration that applicants were in possession of the claimed subject matter prior to the earliest date to which the cited reference is entitled to rely upon. Moreover, this showing provides at least as much evidence of invention as that which is found in the cited reference. Accordingly, this showing is sufficient to demonstrate applicants' conception and reduction to practice prior to the date of the cited reference.

The Office also alleged in the Advisory Action that the data provided did not show Applicants' diligence in reducing their conception to practice. For the purposes of antedating the cited reference, Applicants have shown that they reduced the claimed invention to practice prior to the invention date evidenced by the cited reference. Accordingly, Applicants need not show diligence to overcome the cited reference.

Double Patenting

The Office stated in the Advisory Action that the terminal disclaimer previously submitted had not been reviewed because Applicants had not submitted the appropriate fee. Applicants respectfully note that the Fee Transmittal sheet submitted on April 18, 2005 clearly indicates that the fee for a disclaimer had been submitted. Moreover, the response submitted by Applicants with the terminal disclaimer invites the Commissioner to charge the cost of "fees due in connection with the filing" to our deposit account. In view of this, Applicants respectfully request the Office to review and process the terminal disclaimer previously submitted.

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CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 511582003500. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

By 

James J. Mullen III, Ph.D.

Registration No.: 44,957

MORRISON & FOERSTER LLP

12531 High Bluff Drive

Suite 100

San Diego, California 92130

(858) 720-7940

sd-286792